II. Remarks

Claims 1-22 are rejected and pending. A listing of the pending claims has been provided for the Examiner's convenience. With the remarks provided below, Applicants respectfully request reconsideration and a withdrawal of all rejections.

In one embodiment of the present invention, the grasping device comprises an elongate control member having an atraumatic distal tip section and a grasping portion spaced proximally from the distal tip section. In the present application, the "distal end portion 52 of the control member 50 concludes in a distal tip section 54, and spaced proximally from the proximal end 56 of the distal tip section 54 is the grasping portion 70." *(Specification, page 8, lines 8-10.)* The distal tip section provides a smooth transition between the outer sheath and the guide wire. Moreover, the distal tip section protects the vessel wall and reduces the chance that the grasping device will shear off any atheromatous plaque that is encountered while tracking through the vessel.

Office Action Made Final

Responsive to the final Office action, the final rejections/action placed on the present application are improper. Section 706.07(a) of the M.P.E.P. states in pertinent part as follows:

> "[A] second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

See M.P.E.P. § 706.07(a) (emphasis added). In the final Office action mailed September 8, 2004, the Examiner placed final rejections on claims 1-22 of the present application based on "newly cited art," *e.g., Bates* (U.S. Patent No. 6,096,053). (*See* pages 2 and 3 of the Office action.) Prior to the final Office action, *Bates* had not been cited. Moreover, claims 1-20 are original claims as filed and have not been amended. (*See* original claim set of present application filed

November 1, 2001.) Additionally, claims 21 and 22 are merely new claims added in a reply dated July 17, 2003, responding to a non-final Office action mailed April 17, 2003. Thus, the Examiner has improperly placed final rejections on claims 1-22 of the present application. Reconsideration and a withdrawal of the final rejections/action placed on the present application are respectfully requested.

Claim Rejections – 35 U.S.C. § 102

Responsive to the rejection of claim 1 under 35 U.S.C. § 102(e), *Bates* fails to teach each and every element as set forth in the invention as claimed in independent claim 1. For example, as mentioned above, claim 1 recites a medical grasping device comprising "an elongate control member having an atraumatic distal tip section" and separately "a grasping portion proximal said distal tip section." *Bates* fails to teach such limitations, although the Office action on page 2 suggests that reference numerals 12, 22, and 16 in Fig. 8A of *Bates* are indicative of the elongate control member having an atraumatic distal tip section and a grasping portion as recited in claim 1 of the present application.

Contrarily, *Bates* simply teaches an expandable device 10 comprising a mesh portion 16 secured to the distal end of a catheter 12. *(Column 6, lines 19-23; see also Fig. 8A.)* Cannula 14, which is connected to the interior of the distal tip 22, is disposed in the catheter 14 and extends the entire length of the catheter 14. *(Col. 3, lines 18-22; see also Fig. 8A)* The distal tip 22, which is free from contact with the catheter 12, merely distally engages the opposite end of the mesh portion 16. *Id.* Thus, "when cannula 14 is withdrawn relative to catheter 12, and when tip 22 and the distal end of catheter 12 exert a compressive force on mesh portion 16, mesh portion 16 is free to expand throughout its entire length." *(Col. 3, lines 24-29)* The distal tip 22 neither attaches nor engages with the catheter 12. *(See Figs. 8A-8D)* Hence, *Bates* simply fails to teach an elongate control member having an atraumatic distal tip section and separately a grasping portion proximal the distal tip section as recited in independent claim 1.

Claims 2 and 4-6 are dependent on claims which depend generally from claim 1. Thus, claims 4-6 are allowable for reasons provided above.

Claim Rejections – 35 U.S.C. § 103

Responsive to the rejections of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Bates* and *Gunther et al.* (U.S. Patent No. 5,300,484), the combination does not teach or suggest all the elements of claim 3. Claim 3 is a dependent claim which depends generally from claim 1, the elements of which are not taught or suggested by *Bates*. In addition, there is no suggestion or motivation to combine *Bates* and *Gunther et al.* to provide a hemostatic seal between the sheath and the elongate control member.

Responsive to the rejections of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Bates* and *Avellanet* (U.S. Patent No. 6,264,664), the combination does not teach or suggest all the elements of claim 7. Claim 7 is a dependent claim which depends generally from claim 1, the elements of which are not taught or suggested by *Bates*. In addition, there is no suggestion or motivation to combine *Bates* and *Avellanet* to provide a connecting block affixed to the elongate control member.

Responsive to the rejections of claims 8-22 under 35 U.S.C. § 103(a) as being unpatentable over *Bates* and *Hillstead* (U.S. Patent No. 5,098,440), the combination does not teach or suggest all the elements of claims 8-22. Claims 8-22 is a dependent claim which depends generally from claim 1, the elements of which are not taught or suggested by *Bates*. In addition, there is no suggestion or motivation to combine *Bates* and *Hillstead*.

Conclusion

Therefore, claims 1-22 are in a condition for allowance and such action is earnestly solicited.

Respectfully submitted,

November 8, 2004
Date

Lawrence G. Almeda (Reg. No. 46,151)